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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---------------------------------|-------------|----------------------|---------------------|------------------|
| 10/017,341 | 12/13/2001 | Tom Steinke | STEINKE.005A | 6810 |
| 20995 | 7590 | 04/26/2006 | EXAMINER | |
| KNOBBE MARTENS OLSON & BEAR LLP | | | THALER, MICHAEL H | |
| 2040 MAIN STREET | | | ART UNIT | |
| FOURTEENTH FLOOR | | | PAPER NUMBER | |
| IRVINE, CA 92614 | | | 3731 | |

DATE MAILED: 04/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/017,341 | Applicant(s) STEINKE, TOM | |
| | Examiner Michael Thaler | Art Unit 3731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,11,13-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,11,13-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/7/06</u> . | 6) <input type="checkbox"/> Other: _____ |

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 7, 2006 has been entered.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 depends from canceled claim 1.

Claims 10, 11, 13-16 and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fordenbacher (5,733,328) in view of Ryan (5,830,217). Fordenbacher, in figures 7-9 and 16 discloses a catheter having an expandable member (the balloon catheter described in col. 7, lines 21-24) coupled to an expansion actuator (the source of inflation fluid for the balloon catheter) and a stent (e.g. the stent shown in figure 7) comprising a tubular member comprising a series of sliding and locking circumferential elements 40, 42 (noting that more than two elements may be used to form a "series" as indicated in col. 7, lines 7-14), wherein each element is structurally separate

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from the other elements and forms only a fraction of the circumference of the tubular member, comprising at least one elongated rib (e.g. 41) disposed between first and second transverse end portions (one transverse end portion being at 45 as seen in figure 8 and the other transverse end portion being at 83 as seen in figure 16) and at least one articulating mechanism that permits one-way sliding of the radial elements but prevents recoil from the expanded diameter (the arresting mechanisms which comprises the remainder of the arrowhead structures described in col. 10, lines 1-5 and also noting the phrase "little or no recoil" in col. 6, lines 46-48). Fordenbacher fails to disclose a degradable polymeric coating that holds the stent on the expandable member. However, Ryan teaches that a polymeric coating should be applied to a stent and expandable member in order to obtain the advantage of keeping the stent securely attached to the catheter until deployment is desired (col. 2, lines 35-38 and col. 2, line 64 to col. 3, line 9). It would have been obvious to include a polymeric coating on the Fordenbacher stent and expandable member so that it too would have this advantage. Note that Ryan discloses polyethylene glycol, for example, as the polymer (col. 6, lines 44-51). As to claim 11, note col. 8, lines 60-62 of Ryan. As to claims 13 and 14, Fordenbacher fails to disclose

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radial elements that alternate between radial elements having one rib and radial elements having two ribs. However, it is old and well known in this art to provide such an arrangement in order to provide enhanced strength to the stent. It would have been obvious to this arrangement for the Fordenbacher stent so that it too would have this advantage. The above well known in the art statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertion (M.P.E.P. 2144.03). As to claims 20 and 21, Fordenbacher discloses a frame element the surrounds at least one circumferential element. For example, the member 69 in the center of figure 9 may be considered to be the claimed circumferential element. When this member 69 is inserted into slots 43 on the other component 40, it is surrounded by a frame element that includes portions of components 40 and 42 including the members 69 on the left and right side of figure 9.

Applicant's arguments filed April 7, 2006 have been fully considered but they are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

mht
4/21/06



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731